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Application No.: 09/922,376 Examiner: Smith, Kimberly S.
Applicant: Jeffrey Lynn Chamberlain GAU: 3644
Filed: 08/03/2001 Office Action Date: 06/21/2002
For: ~~DOG~~ DOG WATERING TOY

Response to Office Action

AMENDMENT OF SPECIFICATION

pages and lines refer to convenient substitute Spec.

Applicant respectfully submits amendments to the specification made necessary by the amendments to the drawings made necessary by the Examiner's objections. The amendments are as follows: In section f, the description of the drawings, please rewrite the specification to read "Figure 1 is a [sectional] view of a hamburger shaped embodiment of the invention. Figure 2 is a sectional view of the embodiment of Figure 1 with the section taken along the line 1-1. Figure [2] 3 shows a bone shaped embodiment of the invention with cord attached. Figure [3] 4 shows a steak shaped embodiment of the invention bearing indicia simulating bone. Figure [4] 5 shows the invention in an embodiment including the valves on a nipple like structure. Figure [5] 6 shows a sectional view of the invention without an outer layer and with no noisemaker inside. Figure [6] 7 shows a sectional view of the invention with plunger type valve[and arrows depicting water flow direction]. Figure [7] 8 shows a sectional view of the invention with plunger type valve in closed position. Figure [8] 9 shows the invention in an embodiment featuring slit type valves that are closed. Figure [9] 10 shows the invention in an embodiment featuring slit type valves while the invention is compressed which opens the slits." Page and line numbers refer to substitute specification.

At page 5, lines 5-8 have been amended to read "the section is taken across a plane (1). Reference is made now to Figure 2. The invention consists of a puncture resistant reservoir (2) which can hold water. Reference is now made to Figure 1. The reservoir has a fill aperture (3) through which"

At page 5, line 25 "Figure 2 shows" has been amended to read "Figure [2] 3 shows" and at page 5, line 27 through page 6, line 1 "dog watering toy. Figure 3 shows a dog watering" has been amended to read "dog watering toy. The carrying cord (7) is attached to the toy by an attachment means (7a). Figure [3] 4 shows a dog watering".

At page 6, line 16 has been amended to read "such as that seen at Figure [4] 5. This latter means would be".

At page 7, line 23 which had read "Referring now to Figure 5, an additional feature could" Applicant amends it to read "Referring now to Figure [5] 6, an additional feature could"

At page 8, line 3 which had read "outer layer. Referring now to Figure 6, the valve (5) is" Applicant amends it to read "outer layer. Referring now to Figure [6] 7, the valve (5) is"

At page 8, lines 8-10 Applicant amends the specification to delete the sentence "[Water can then exit the toy in the direction indicated by the arrows in Figure 6]"

At page 8, line 12 which had read "chewing pressure is

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released. Figure 7 shows the toy in" Applicant amends that line to read "chewing pressure is released. Figure [7] 8 shows the toy in".

At page 8, line 17 which had read "At Figure 8 is a valve embodiment in which the valves" Applicant amends it to read "At Figure [8] 9 is a valve embodiment in which the valves".

At page 8, line 19 which had read "Figure 9 the embodiment of Figure 8 is shown as it" Applicant amends it to read "Figure [9] 10 the embodiment of Figure [8] 9 is shown as it".

The above changes are all shown in context in the substitute specification provided for clarity. The substitute specification contains no new matter. Since the number and locations of all the changes necessitates so much painstaking work, the examiner is suggested to use the substitute specification pursuant to 37 CFR 1.125. Failing that, the examiner can use the reference specification provided with the changes in context to seek and enter the amendments on the original specification. Please rewrite the specification in accordance with the above amendments as shown on the reference specification provided.

AMENDMENTS TO DRAWINGS

Applicant amends the drawings in response to Examiners objections explained in examiner's paragraphs 1-3. Informal copies of the new figures 1-10 are submitted herewith for approval by the examiner. The are submitted as separate sheets.

The attachment means is shown as feature 7a on Figure 3. Detailed illustration of the claimed element is not necessary for a proper understanding of the invention since an ordinary worker in the field would know how to attach a cord to a toy. The attachment means is therefore shown as a set of labeled rectangular boxes pursuant to 37 CFR 1.83 and doing so is not new matter since the attachment means was mentioned in the original application at claim 10 and claim 18.

With respect to the objection to Figure 6, there is no wall flexing outwardly. Applicant respectfully believes that the examiner has been confused by arrows applicant placed on the figure to indicate water flow. Applicant has amended the drawing to omit these arrows. Applicant must respectfully traverse the examiner's objection regarding a "wall by the return means flexing outwardly" because the wall (10) is depicted by parallel lines which form a rectangular cross section with corners that are 90 degree angles. Applicant is at a loss to understand how this is flexing outwardly and cannot ask because the examiner has been on vacation and her supervisor did not return Applicant's attorney's telephone message. The valve mechanism can clearly be seen to be inward in old Figure 6, compared to how that same feature referenced as (11) was configure at old Figure 7. When it is in, as at old Figure 6, Water can flow into the openings (12). The drawings show this and the text specifically explains it.

Applicant has complied with Examiner's requirement for an amendment of Figure 1. Applicant respectfully requests that the examiner enter the amendments to the drawings as shown on the submitted copies. Applicant respectfully requests that the examiner withdraw her objection to old Figure 6 (New Figure 7) as respects a "wall by the return means flexing outwardly" as there is no wall by the return means flexing outwardly.

AMENDMENT TO CLAIMS

With respect to rejections under 35 U.S.C. 112: Applicant respectfully requests amendment of claims 6, 8, 9, 14, and 20 as follows:

Rewrite claim 6 to read:

6. (Amended) The apparatus of claim 1 wherein said valves are [nipple like structures] nipples.

Rewrite claim 8 to read:

8. (Amended) The apparatus of claim 7 [further comprising] wherein said pressure is applied to said valve mechanism.

Rewrite claim 9 to read:

9. (Amended) The apparatus of claim 7 [further comprising] wherein said pressure is applied to said wall.

Rewrite claim 14 to read:

14. (Amended) The apparatus of claim 7 further comprising a [nipple like structure] nipple, said [nipple like structure] nipple extending from said wall, said valves being located on said [nipple like structure] nipple.

Rewrite claim 20 to read:

20. (Amended) The pet care apparatus of claim 15 further comprising said reservoir having a [nipple like structure] nipple, said [nipple like structure] nipple extending from said wall, said valves being located on said [nipple like structure] nipple.

Applicant must respectfully traverse examiner's rejection of claim 15 under 35 U.S.C. 112. The examiner is respectfully requested to reconsider her position and withdraw the rejection. As grounds: persons skilled in the art can discern the meaning.

With respect to rejections under 35 U.S.C. 103:

Applicant must respectfully traverse examiner's rejection of claims 1, 2, 7-9, 11 and 14 based on Dorta on the grounds that Dorta is diverse art and doesn't apply, that there is no secondary reference, that examiner offers no case law to support her position, and secondary considerations show these claims are nonobvious.

Applicant must respectfully traverse examiner's rejections of claims 15, 16, 18, 19, and 20 based on Warehime on the grounds that Warehime is diverse art and doesn't apply, that there is no secondary reference, that examiner offers no case law to support her position, and secondary considerations show these claims are nonobvious.

Applicant must respectfully traverse examiner's rejections of claims 3 and 12 based on Dorta in view of Sofia on the grounds that Dorta and Sofia are both diverse art from Applicant's invention and that Dorta and Sofia are also in diverse art areas with respect to each other. Sofia teaches away from the instant invention, examiner offers no case law to support her position, and secondary considerations show that the invention is nonobvious.

Applicant must respectfully traverse examiner's rejections of claims 4 and 10 based on Dorta in view of Rubin on the grounds that Dorta and Rubin are diverse art from the instant invention, they teach away from each other, examiner offers no case law

to support her position, and secondary considerations show that the invention is nonobvious.

Applicant must respectfully traverse examiner's rejection of claims 5 and 13 based on Dorta in view of Warehime on the grounds that Dorta and Warehime are both diverse art and in fact are diverse from one another, they teach away from the instant ~~XX~~ invention, examiner offers no case law to support her position, and secondary considerations show these claims are nonobvious.

Applicant must respectfully traverse examiner's rejection of ~~XXXXXX~~ claim 17 based on Warehime in view of Sofia on the grounds that Warehime and Sofia are both diverse art from ~~a~~ the instant invention, they are diverse from one another, ~~E~~ examiner offers no case law to support her position, and secondary considerations show these claims are nonobvious.

Therefore, Applicant respectfully requests that examiner reconsider all the above rejections based on 35 U.S.C. section 103 and withdraw the rejections.

REMARKS

Applicant has made substantial amendments to the specification due to the need to renumber the figures and consequently the text passages that refer to the figures by number. Applicant has also removed a copule of references in the specification to arrows that had been apparently confusing on Figure 6, and were therefore removed. Applicant provides a substitute specification, to which no new matter has been added, and suggests the examiner use it rather than to undertake the laborious task of entering all the amendments on the original.

Applicant has amended the drawings in compliance with examiner's requirement and for clarity. Applicant submits as separate sheets informal copies of the proposed drawing amendments for the examiner's approval.

Applicant has amended claims 6, 8, 9, 14, and 20 in compliance with the Examiner's requirement and respectfully requests the examiner to enter those amendments.

Applicant's traversal of the examiner's rejection of claim 15 under 35 U.S.C. 112 is on the grounds that a person skilled in the relevant art would know that in a reservoir having a compressible wall and an airtight cap, compressing the wall will automatically result in a net greater pressure inside the reservoir as opposed to outside the reservoir. (See paragraph 2 of the Declaration of Jeffrey Chamberlain, attached hereto as Exhibit "1" and herein incorporated by this reference.) Applicant respectfully requests that the examiner reconsider her rejection of claim 15 on this ground and withdraw her rejection.

Applicant's traversal of the examiner's rejection of claims 1-5 and 7-20 based on 35 U.S.C. 103 is on the following grounds: where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the nonobviousness of the invention. (In Re Nomiya, et al., 184 U.S.P.Q. 607, 612-613 (C.C.P.A. 1975)).

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When the alleged prior art does not specifically address the types of problems addressed by the technology of the invention, The prior art alleged is not applicable in combinations to render the invention obvious. (Caster v. U. S., 9 U.S.P.Q. 2d 1753 (Cls. Ct. 1988)).

When the alleged prior art is neither in the same field of endeavor nor pertinent to the problem to be solved there can be no obviousness rejection under 35 U.S.C. 103. (In Re Clay, 23 U.S.P.Q. 2d 1058 (Fed. Cir. 1992)).

As has been pointed out in the Declaration of Jeffrey Chamberlain, at Exhibit "1", the instant invention is about using the characteristic chewing behavior of dogs to solve the problem of providing a portable and fun means of watering the animals. This is corroborated by the many references in the original specification to the fact that that is the whole point of this invention. As Mr. Chamberlain pointed out, Dorta is for children, not dogs. Human children do not exhibit a dog's characteristic chewing behavior. Dorta also has an actuator which must be pushed, not chewed. Dorta is hard on the outside and has as one of its objects that it will not release its contents during play. Chewing itself is play for a dog. Dorta teaches away from Chamberlain, it does not specifically address the problem of using chewing behavior to activate release of water from a dog toy, and since it is for human children it is not even in the same field of endeavor as the instant invention.

The Warehime device is also for infants rather than dogs. it is specifically designed to simulate the mother's breasts. Since mothers do not want their infants chewing on their breasts, Warehime also teaches away from the instant invention. It is in a different field of endeavor. It does not specifically address the problem of how to use a dog's chewing behavior to release water from a toy.

The Sofia patent regards a device for teething human infants rather than for dogs. It does not release any liquid. It is constructed to fit on the infant's hand. Dogs do not have hands. This patent does not specifically address the problem of how to use a dog's chewing behavior to release water from a toy. Since it is for infants and does not contain liquid, it is not even in the same field of endeavor as the instant invention. Since it is specifically to encourage chewing, Warehime obviously teaches away from it since no mother in her right mind is going to train her infants to chew on her breasts.

The Rubin patent concerns a device which contains food rather than liquids. It has holes that are always open, not valves. The animal causes food to fall out of the holes by rolling the device around, not by chewing. The device purposefully releases food when it is played with while Dorta has as one object of its invention that it will not release its contents during play. These two patents specifically teach away from each other. The Rubin device does not hold liquids, and it does not specifically address the problem of how to use a dog's characteristic chewing behavior to release water from a toy. It is not in the same field of endeavor as the instant invention.

Since none of the references relied upon by the examiner

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is in the same field of endeavor as the instant invention, and none of the reference relied upon by the examiner specifically addresses the type of problem addressed by the instant invention, there can be no finding of obviousness under 35 U.S.C. 103 stemming from these references.

Affidavits or declarations containing evidence of criticality, unexpected results, commercial success, long-felt but unsolved needs, failure of others, and skepticism of experts must be considered by the examiner in determining the obviousness of claims for patentability under 35 U.S.C. 103. (MPEP section 716.01(a)). (See also Strato flex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983)).

Evidence of direct and indirect comparative tests are probative of nonobviousness. (In Re Boesch, 617 F.2d 272, 205 U.S.P.Q. 215 (C.C.P.A. 1980)). Evidence of unexpected results must be weighed before making a final determination regarding obviousness. (In Re May, 197 U.S.P.Q. 601 (C.C.P.A. 1978)).

Third parties, such as licensees who have a contract with inventor, can add weight to contentions of long felt but unsolved need. (In Re Tiffin, 170 U.S.P.Q. 88 (C.C.P.A. 1971)).

Referring now to the Declaration of Alan Tratner attached hereto as Exhibit "2" and herein incorporated by this reference, Mr. Tratner, whose organization has a bona fide membership agreement with Mr. Chamberlain, provides evidence of long felt but unsolved need, unexpected results, and market research that indicates a very high approval rating for the product and a likelihood of commercial success. Note that even the public prefers the version of the toy tested as a chew version rather than as a plush (like Sofia) or a squeeze version. This declaration and its attached market survey results show that the dog watering toy does in fact show unexpected results, does satisfy a long felt but unsolved need, does overcome the failure of others and will very likely enjoy commercial success when fully marketed. Applicant respectfully requests that the examiner reconsider her rejection of claims 1-5 and 7-20 based on 35 U.S.C. 103 and withdraw the rejections.

Respectfully submitted,



Charles R. Sutton Reg. No. 42,176
(818) 780-6616

CERTIFICATE OF MAILING

I hereby certify that this correspondence and the papers to which it refers are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on September 20, 2002



Charles R. Sutton Reg. No. 42,176

Chamberlain Response to First Office Action, 09/922,376

Exhibit "1"